

REMARKS

Reconsideration and withdrawal of the rejections of the application are respectfully requested in view of the amendments and remarks herewith, which place the application into condition for allowance or into better condition for an appeal.

This invention provides for *inter alia* thermochemically modified starches. Applicants discovered a simple and surprisingly effective alternative to conventional processes for preparing thermochemically modified starches.

Although it is believed that no fee is required for consideration of this paper, if a fee is due, then the Assistant Commissioner is authorized to charge such fee, or credit any overpayment, to Deposit Account 50-0320.

Claims 17 to 41 are pending. Claims 17 and 24 are amended without prejudice, admission, surrender of subject matter or intention of creating estoppel as to equivalents and claims 42 to 44 are added. Support for the added claims 42 and 43 is found on page 3, second paragraph of the specification, and support for the added claim 44 is found on page 6, second paragraph of the specification. Therefore, no new matter is added. Since these claims recite a narrower range for the moisture content of the starch, these claims do not add material that requires further consideration and/or search.

Claims 17 to 41 stand rejected under 35 U.S.C. §112, first and second paragraphs. Applicants have followed the helpful suggestions of the Examiner and have amended the claims accordingly. As Applicants amended these claims at the suggestion of the Examiner it is urged that these changes do not require further consideration and/or search and overcome these rejections.

Claims 17-41 stand rejected under 35 U.S.C. §102(b) for allegedly being anticipated by Hershenson et al., US 3,523,938 ("Hershenson"). As Hershenson does not teach a process wherein the moisture content is less than 20%, it does not teach each and every element of the invention as claimed. Accordingly, reconsideration and withdrawal of this rejection are requested.

Hershenson describes a process in which an aqueous starch suspension is hydrolyzed by the addition of acid. In the process, the starch is present as a slurry at a concentration of 65 to 75% by weight with the remainder being water (see column 2, lines 40 to 42).

In contrast to the process disclosed in Hershenson, the inventive process, as claimed, is directed to a "semi-dry" process, in which the moisture content is less than 20%. In other words, the inventive process is not directed to a slurry process which contains a large amount of water. The inventive process is an environmentally-friendly process, wherein the starch is not placed into suspension with water but is sprayed with only catalytic amounts of acid. It is for this reason claim 17 recites the element "having a moisture content of less than 20%." New claims 42 and 43 are even further removed from the process described in Hershenson since these claims provide for a process in which the moisture content is less than about 15 to 20% and to less than 10%, respectively. Thus, as the process described in Hershenson does not meet the claim element of "contracting a starch having a moisture content of less than 20% with an acid," Hershenson cannot anticipate instant process of preparing thermochemically-modified starches and the reconsideration and withdrawal of the rejection are requested.

Claims 17 to 41 are rejected under 35 U.S.C. §102(b) for allegedly being anticipated by Klingler et al. ("Klinger"). As Klinger does not specifically teach a process for the acid

modification of a starch other than green pea starch, it cannot anticipate the present claims and the withdrawal of the rejection is requested.

Klinger discloses semi-dry process for acid modification of green pea starch. Although the abstract refers to starch in general, Klinger only teaches a semi-dry process for the acid modification of green-pea starch with an amylose content of exactly 34.6%. Hence, it cannot anticipate the present claims.

With respect to the translation issue raised in the rejection concerning the term “green-pea,” it should be noted that Klinger discloses specific type of pea named “Palerbse.” This term is translated into English as “green-pea” (please see the plant name database at <http://www.gmr.landfood.unimelb.edu.au/Plantnames/Sorting/Pisum.html>.) (copy attached). Thus, Applicants urge that the teaching of Klinger does not anticipate subject matter of the invention, as claimed, since it refers only to “Palerbse” (green-pea) which is specifically excluded by the provision in the claim 17 of the instant invention.

Moreover, it is respectfully urged that Klinger would not suggest to one of ordinary skill in the art that the process disclosed therein could be used with starches other than green pea starch, since it does not provide any suggestion that other starches could be used in the semi-dry acid modification process directed therein. The starches disclosed in the instant application, such as corn, wheat, tapioca, mung-bean or potato, differ significantly in structure and properties (e.g., amylose content, phosphate content, etc.) from green pea starch described in Klinger. Klinger does not provide any motivation or suggestion that other starches may be used, a suggestion that is necessary in view of the wide divergence in the statement and preparation of starch. While, at best, it might be obvious to try to use other starches in the process disclosed in Klinger, “obvious to try” is not the standard for patentability under 35 USC §103(a). *Hybritech Inc. v. Monoclonal*

Antibody, Inc. 231 USPQ 81, 89 (Fed. Cir. 1986); *In re Greiger*, 2 USPQ2d 1276 (Fed. Cir. 1987); *In re Merck*, 231 USPQ 375 (Fed. Cir. 1986).

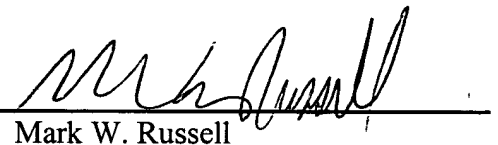
Consequently, reconsideration and withdrawal of the Section 102 rejections are respectfully requested.

Early and favorable examination on the merits is earnestly solicited.

Respectfully submitted,

FROMMER LAWRENCE & HAUG LLP
Attorneys for Applicants

By: _____



Mark W. Russell

Reg. No. 37,514

Telephone: (212) 588-0800

Facsimile: (212) 588-0500